

REMARKS/ARGUMENTS

The issues raised in the Office Action dated December 4, 2003 have been considered. Claims 1-40 and 51-59 are pending in the application: Claims 1-40 stand rejected; Claims 41-50 stand withdrawn; and Claims 51-59 are new. Reconsideration and allowance of the application is respectfully requested.

Pursuant to MPEP § 818.03(c), Applicant reserves the right to petition the restriction of Claims 41-50 at a later date.

With Claims 41-50 presently being withdrawn from consideration, at issue are Claims 1-50 and Claims 51-59, with Claims 1, 21 and 22 being independent. Claim 22 has been amended to incorporate the subject matter of original Claim 21, and Claim 21 has been amended to incorporate related subject matter. New Claims 51-59 are dependent on Claim 21. Authorization is hereby provided to charge deposit account No. 50-0996 (NOKV.008PA) for \$86.00 for one additional independent claim (one over the three allowed, two having been previously charged for) and \$162.00 for nine additional claims (nine over the twenty allowed, 30 having been previously charged for). Authorization is also hereby provided to charge/credit deposit account No. 50-0996 (NOKV.008PA) for any under/over payment in connection with the instant Office Action Response.

Regarding the rejections, the Office Action indicates that: Claim 3, 7, 8 and 12 stand rejected under 35 U.S.C. §112(2); Claims 1-7, 9-14, 21-26, 33-35, and 37-40 stand rejected under 35 U.S.C. §102(e) over *Quelene* (U.S. Publication No. 2002/0038292); Claims 8 and 36 stand rejected under 35 U.S.C. §103(a) over *Quelene* as applied to Claims 5 and 24; Claims 15, 16, 27, and 28 stand rejected under 35 U.S.C. §103(a) over *Quelene* as applied to Claims 14 and 26 and further in view of *Kojima et al.* (U.S. Publication No. 2002/0038292); Claims 17-19 and 29-31 stand rejected under 35 U.S.C. §103(a) over *Quelene* as applied to Claims 1 and 22 and further in view of *Kojima et al.*; and Claims 20 and 32 stand rejected under 35 U.S.C. §103(a) over *Quelene* as applied to Claims 1 and 21 and further in view of *Melchior et al.* (U.S. Publication No. 2002/0038292). For the reasons provided below, *inter alia*, Applicant respectfully traverses each of these rejections.

Applicant respectfully submits that Claim 3, 7, 8 and 12 satisfy the requirements of 35 U.S.C. §112, including §112(2). The rejection of each of these claims is founded on a

wording issue, namely lack of antecedent basis. This wording issue, however, does not necessarily give rise to a rejection under §112. As explained in M.P.E.P. § 2173.05(e) (Lack of Antecedent Basis), “the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” For each of Claims 3, 7, 8 and 12, its scope would be reasonably ascertainable by those skilled in the art in view of the original claim wording, the Detailed Description and/or the claim’s dependency; therefore, the claim is not indefinite under §112(2). Notwithstanding Applicant’s traversal, each of Claims 3, 6, 7, 8 and 12 have been amended to improve the implicit antecedent basis and to expedite prosecution. In view thereof, Applicant submits that the rejections should be removed.

Applicant respectfully submits that Claims 1-7, 9-14, 21-26, 33-35, and 37-40 are patentably distinguishable from *Quelene* and that the Office Action has failed to set forth a *prima facie* §102(e) rejection. *Quelene* is directed to implementing a transaction wherein a purchaser sends a selection signal to a vendor indicating an item to purchase. The vendor generates a proposal identifying a good for sale and the price. The vendor sends the proposal out to all of its business relations (p.4, para. 0048). These business relations add a cost markup for their services, and pass it on to still other business relations to do the same. (Id.) This occurs until one or more modified proposals reach the purchaser. (Id.). The purchaser then selects one of the proposals, and sends an “order” directly to the vendor associated with the selected proposal to create the contract. One cited aspect of *Quelene* is directed to a vendor-related intermediary that modifies proposals prepared by the vendor before a buyer accepts such a modified proposal (p.2, para. 0017-0018).

The §102(e) rejection fails to provide an explanation of correspondence between the claimed invention and the asserted embodiments of *Quelene*, and Applicant fails to recognize how such correspondence might be established. For example, for the rejection of claims 1 and 21, the Office Action appears to rely on *Quelene* paragraphs 0018 and 0019; however, these paragraphs do not include any discussion of the limitations involving the claimed trusted server.

Correspondence for the rejection of claim 2 (also involving the trusted server) is said to be found in *Quelene* paragraph 0017, but paragraph 0017 does not mention any structure or

function that might correspond to the trusted server as set forth in claim 1 or claim 2. As mentioned above, *Quelene* paragraph 0017 discusses a vendor-related intermediary that modifies the vendor proposals before a buyer accepts such a proposal. In contrast, Claim 2 requires that the trusted server identify whether the merchant system has modified the contract. Assuming that the Office Action is referring to *Quelene*'s vendor-related intermediary (paragraph 0017), this intermediary is not adapted to prepare the contract and return the accepted contract to the merchant system and identify whether the merchant system has modified the contract. Rather, *Quelene* teaches the opposite: the merchant system prepares the proposed contract and the vendor-related intermediary modifies the proposed contract. If the Office Action is not referring to *Quelene*'s vendor-related intermediary (paragraph 0017) in this context and the rejection would be maintained in the next Office Action, Applicant requests clarification and adequate opportunity to respond.

Each of Claims 1, 21 and 22 is directed to Applicant's claimed trusted server adapted to communicate with merchant and buyer systems as claimed and as largely corresponding to the discussion provided above in connection with §102(e) rejection. Therefore, Applicant traverses each of the claim rejections for at least the above-discussed reasons. Each of these remaining claim rejections rely on §103(a) using the interpretation of *Quelene* as applied in the above §102(e) rejection. Applicant further submits that new (dependent) Claims 51-59 are distinguishable over the cited references for at least these same reasons. While Applicant believes that further deficiencies with the rejections are present, further comment should not be necessary.

If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him at (651) 686-6633 to discuss any issues related to this case.

Respectfully submitted,

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